

REMARKS/ARGUMENTS

The present application has been carefully reviewed in light of the February 2, 2005 Office Action. In response, Applicant has amended claims 1, 13-16, and 22-24. Moreover, claims 2, 9-12, 17, 25 and 28-29 have been canceled. In light of the foregoing amendments and following remarks, Applicant respectfully requests reexamination and reconsideration of the application, as amended.

TIME EXTENSION REQUEST

Applicant submits herewith a one-month time extension request, with appropriate fee.

SPECIFICATION

Applicant, thanks the Examiner for the discrepancy in the Abstract, and has made the suggested correction, as indicated above.

CLAIM OBJECTIONS/REJECTIONS

Applicant has amended claims 13 and 16 to correct the grammatical errors noted by the Examiner.

All claims 1-29 were rejected under 35 U.S.C. § 103 as being unpatentable over various combinations of references.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. M.P.E.P. §2143 (citing In re Vaeck, 20 USPQ 2d 1438 (Fed.Cir. 1991)).

Claims 1, 2, 3, 9 and 14 were rejected as being unpatentable over Bielski, in view of RealStores.com, and Internet's First. Claim 1 has been amended to include the recitations of claims 2, and 9-12. Claims 10, 11, 12 and 13 were rejected as being unpatentable over Bielski, RealStores.com, Internet's First, and further in view of the Examiner's "official notice". Applicant respectfully traverses these objections. Applicant's invention is directed to a method for making purchase transactions over the world wide web, or Internet, wherein a card is purchased having a unique identification code and a predetermined cash balance, and the card and associated account is activated by providing a card service system only the identification code and not any personally identifying information (see amended independent claims 1, 16 and 24).

Although Bielski teaches a method of making purchases on the Internet using a card of unique identification code and predetermined cash balance, Bielski does not teach of providing only the identification code, and no personally identifying information.

Independent claim 1 (as well as independent claims 16 and 24), further recite that when the card holder selects one or more goods or services offered by a seller through a web-site, the identification code of the card is provided to the seller, who then transmits the identification code to the identification system for verification. The verification by the card service system includes the steps of determining if the identification code is associated with a valid and active account by searching a data base of activated accounts, and if there is sufficient cash balance in the account to purchase the selected goods or services, then an approval code is transmitted to a seller and a purchase price of the selected goods or services is debited from the cash balance of the account. If the identification code is determined invalid, or there is insufficient cash balance in the associated account to purchase the selected goods or services, a denial code is transmitted to the seller.

On page 3 of the Office Action, the Examiner admits that Bielski does not disclose providing the identification code of the card to the seller who then transmits the identification code to the card service. However, the Examiner combines Internet's First teachings with Bielski and RealStores.com in an attempt to reject these claims.

However, in direct contrast to the teachings of the present invention, Internet's First discloses a card system referred to as "Cybermoola cards", wherein parents or guardians go on-line and use a credit card link to their personal identification to by a "Cybermoola" card for their teenage son or daughter. This enables teenagers without credit cards to make Internet purchases. However, when the teenager activates the Cybermoola card, he/she must fill out a form in order to complete the activation. Therefore, personal information is associated with both the purchase of the card initially by the parents, as well as the activation of the card - exactly against the teachings of the present invention.

The teachings of Bielski and Internet's First are only analogous to one another given the teachings of the present application, otherwise, the references are completely non-analogous. Of course, it is axiomatic that a claimed invention is not obvious solely because it is composed of elements that are individually found in the prior art. *Life Technologies, Inc. v. Clonetech Laboratories, Inc.*, 56 USPQ 2d 1186 (Fed. Cir. 2000).

The Examiner picks and chooses aspects of the references in light of Applicant's claims in attempting to reconstruct Applicant's invention. The Examiner's assertions are not supported by the references, but are impermissible hindsight based upon the teachings of Applicant's invention:

"When prior art references require selective combination...to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself..."

Uniroyal Inc. vs. Rudkin-Wiley Corp. 5 USPQ 2d 1434, 1438 (Fed. Cir. 1988). It is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention, and the Examiner must avoid the "insidious effect of a hindsight syndrome wherein only that which the inventor taught is used against the teacher". *W.L. Gore & Assoc. v. Garlock*, 721 F.2d 1540, 1552, 1553, 220 USPQ 303, 312, 313 (Fed. Cir. 1988).

The burden is on the Examiner to particularly identify the suggestion, teaching, or motivation in the reference(s) for their combination, and not just

naming similarities between the reference(s) and the claimed invention. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654 (Fed. Cir. 2000), 57 USPQ 2d 1161, 1166; *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), 50 USPQ 2d 1614, 1618.

“[A] rejection cannot be predicated on the mere identification ... of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”

Ecolochem Inc. v. Southern California Edison, 56 USPQ 2d 1065, 1076 (Fed. Cir. 2000) quoting *In re Rouffett*, 149 Fed. 3d 1350, 1357 (Fed. Cir. 1998), 47 USPQ 2d 1453, 1456.

Applicant respectfully asserts that Bielski and Internet's First should not be combined with one another as Internet's First directly teaches contrary to the present invention.

The Examiner applies various “official notices” to supplement the combination of these references. For example, the Examiner admits that neither Bielke, Realtors.com nor Internet's First expressly discloses searching a data base of activated accounts, transmitting an approval code to the seller if the identification code is valid and a sufficient cash balance is available in the associated account to purchase the selected goods or services, nor transmit a denial code to the seller if an identification code is invalid or there is insufficient balance in the associated account to purchase the selected goods or services. Applicant respectfully asserts that such “official notices” are contrary to the requirements in MPEP § 2144.03, as the Examiner has not provided documentary evidence to support such assertions. Applicant believes that these steps are not capable of instant and unquestionable demonstration as being well-known, and that the Examiner cannot simply reach conclusions based on his or her own understanding, experience, or assertion of “knowledge” in the art without evidentiary support. Applicant respectfully asserts that such steps were not in use with cards for making purchase transactions over the world wide web having

only a unique identification code and a predetermined balance, and no personally identifying information associated therewith.

From the foregoing, Applicant respectfully asserts that independent claim 1, as well as independent claims 16 and 24, are patentably distinct from the combined references, as amended.

Claims 5, 6 and 7 (as well as claims 16, 19 and 20) recite that the activating step of the present invention includes calling the card service by telephone and providing the identification code, such as by inputting the identification code via key-strokes of a key pad of the telephone when prompted by an automated system, or providing the identification code by voice which is deciphered by voice recognition software.

These claims were rejected as being unpatentable over Bielski, RealStores.com, Internet's First, and further in view of Examiner's "official notice". However, the Examiner admitted that none of the cited references disclosed such steps. Applicant respectfully traverses Examiners assertion that "it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the activating step include calling the card services by telephone and providing the identification code, whether by keypad or voice, for the obvious advantage of an enabling users to activate their card without having to log onto the Web". In fact, Applicant asserts that just the opposite is true. All three references (Bielski, RealStores.com and Internet's First) describe activating cards at a web-site. None of them discuss whatsoever the activation by telephone. Applicant argues that this is evidence of the non-obviousness of these steps.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03 (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970). As none of the references teach these claim limitations, Applicant respectfully asserts that claims 5-7, 16, 19 and 20 are patentably distinct and entitled to allowance. Claims 14, 22 and 24 recite that a cardholder can determine the current card account cash balance by

contacting the card service system. Such is simply not disclosed whatsoever in Bielski, RealStores.com nor Internet's First.

Claims 15, 23 and 24 recite that a card holder transferring a minimal cash balance from one card account to another card account by contacting the card service system. As described in the Specification, this enables a card having a very low balance to be combined with another account having a larger balance such that purchases can be made which are greater than the minimal account balance.

The Examiner combines Bielski, RealStores.com, Internet's First and NYCE in rejecting these claims. However, NYCE teaches person-to-person transfers using a debit card. This is non-analogous to the present invention as NYCE does not disclose whatsoever the transferring of a persons minimal balance from on one card to another card owned by the same person. In fact, the exchange of debit card numbers taught by NYCE teaches away from the claims of the present invention, and is in no way analogous. Accordingly, Applicant respectfully asserts that these claims are patentably distinct from the cited references as well. In light of the foregoing, Applicant respectfully submits that claims 1, 3-8, 13-16, and 18-24, and 26-27 are in condition for allowance, notice of which is hereby respectfully requested.

Respectfully submitted,

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